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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,269	01/22/2001	Takashi Sako	AA335/VB	5067

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EXAMINER

WEBMAN, EDWARD J

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 02/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SUPPL
Office Action Summary

Application No.

09/744269

Applicant(s)

SATO

Examiner

WEBMAN

Group Art Unit

1617

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 5/10/04
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-10 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-10 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 1617 *THE PREVIOUS ACTION, COUNTED AS NON-FINAL IN ERROR, IS WITHDRAWN.*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 4, 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Hitchen.

Hitchen teaches shampoo compositions comprising copolymers of carboxylic acid such as Carbopol-1342, an aqueous carrier (water) abstract, col. 3, lines 62-63; visible particles, namely titanium coated mica (abstract) viscosity modifiers such as thickeners col. 5, line 52), and a silicon compound (abstract).

Propylene Glycol is disclosed (column 9 examples 8-11). Applicants characterize it as a humectants (page 3 lines 34-35). Cationic conditioning agents are specified (column 4, line 35 et seq.).

Applicants argue but do not claim an absence of surfactants. Applicants' surprising result is not relevant in a rejection under 35 USC 102.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hitchen in view of Karlen et al and Rath et al.

Hitchen is discussed above.

Karlen et al. teach hair-cleansing compositions comprising copolymers of carboxylic acid such as Carbopol-1342 (column 6, line 62), and an amphoteric conditioning polymer such as Merquat Plus 3300, (see column 7, line 55). Aqueous carriers (water) (column 8, line 58) and a silicon compound (column 6, lines 11-13) are also disclosed.

Rath et al. teach shampoo and conditioner compositions comprising optical brighteners such as shine enhancers, herbal extracts and UV absorbers (column 2, lines 24-28, example 14). Viscosity modifiers such as a thickening composition are also disclosed (abstract).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to add Merquat Plus 3300 to the composition of Hitchen to achieve the beneficial effect of an amphoteric conditioner in view of Karlen et al.

As to other claimed "...further comprising..." ingredients, it would have been obvious to a person of ordinary skill in the art to further include such compounds in the obvious composition of Hitchen in view of Karlen to achieve the extra beneficial effect of these additives in view of Rath et al.

Applicants' limitation of "For Leave – On Use" is merely and intended use not considered a patentable limitation during the prosecution of composition claims before the USPTO.

Applicants argue that there is no motivation to combining to resolve the problem of sticky feeling recognized by applicants. However, the motivation to combine need not be applicants'. In re Dillon 16 USPQ2d 1897 (Fed. Cir. 1990).

Applicants argue a sureprising result but have not shown that Hitchen does not possess the argued property of stickiness.

Claims 5, 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"Additional" in claims 5 and 9 does not have an antecedent in claim 1 and claims 1, 3-8 respectively.

Applicants' respond that the meaning of the term is clear from the disclosure. However, applicants have not cite language indicating that the clear meaning of "additional" is to be ignored.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Webman whose telephone number is (571) 272-0633. The examiner can normally be reached on Monday to Friday 9 Am 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Webman/LR
October 5, 2004

EDWARD J. WEBMAN
PRIMARY EXAMINER
(571) 272-0633

